

II. SUMMARY OF THE INVENTION

Independent claims 1, 11, and 21 are generally directed to a method, apparatus and computer program carrier for providing co-browsing by users shopping over a computer network. The method comprises (a) providing a network site offering items for sale, (b) monitoring the browsing patterns of a first user of the network site and of a second user of the network site, (c) identifying a common browsing pattern of the first and second users, (d) informing the users of the common browsing pattern, (e) providing to the first user of the network site capability to inform the network site of interest in co-browsing with the second user, (f) providing to the second user of the network site capability to inform the network site of interest in co-browsing with the first user, and (g) providing a capability for communication between the interested first and second users while they continue to shop on the network site. Further features of the invention are recited in dependent claims. For example, claim 2 adds the feature: providing users with a window for interfacing with the network site, wherein the window comprises a first pane that displays information relating to items for sale and a second pane that displays content of the communication between the first and second user.

III. PRIOR ART REJECTIONS

In paragraph (4) of the Office Action, claims 1-3, 6-13, 16-23, and 26-30 were rejected under 35 U.S.C. §103(a) as being unpatentable over Fernandes in view of Hodges et al.'s book on multimedia computing, 1993 (Hodges), and further in view of Bull et al., U.S. Patent No. 5,901,287 (Bull), and Sonnenreich et al., U.S. Patent No. 5,974,446 (Sonnenreich).

Applicant respectfully traverses these rejections.

A. LEGAL STANDARD FOR OBVIOUSNESS

Three criteria must be met to establish a *prima facie* case of obviousness. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or combine reference teachings. Second, there must be a reasonable expectation of success. Third, the prior art references must teach or suggest all the claim limitations. MPEP §2143.

With regard to the first criterion, the prior art must suggest the desirability of the claimed invention. The fact that references can be combined or modified is not sufficient to establish *prima facie* obviousness. In *re* Mills, 916 F.2d 680, 16 USPQ2d 1430 (Fed. Cir. 1990); In *re* Fritsch, 972 F.2d 1260, 23 USPQ2d 1780 (Fed. Cir. 1992). Moreover, the fact that the claimed invention is within the capabilities of one of ordinary skill in the art is not sufficient by itself to establish *prima facie* obviousness. *Ex parte* Levengood, 28 USPQ2d 1300 (Bd. Pat. App. and Inter. 1993). It is also insufficient to base an obviousness rejection on an assertion of general common knowledge within the art without articulating that knowledge and placing it on the record. In *re* Lee, 61 USPQ2d 1430 (Fed. Cir. 2002).

Regarding the third criterion, the prior art must teach or suggest all limitations of the claim. In *re* Royka, 490 F.2d 981, 180 USPQ 580 (CCPA 1974). "All words in a claim must be considered in judging the patentability of that claim against the prior art." In *re* Wilson, 424 F.2d 1382, 1385, 165 USPQ 494, 496 (CCPA 1970).

B. TEACHINGS OF THE CITED REFERENCES

1. Fernandes

Fernandes merely discusses a program that "allows for simultaneous browsing on different World Wide Web sites while having a conversation". This reference to "simultaneous browsing" on **different** sites means a single user browsing a first site and second site simultaneously. It does not refer to a first user and a second user browsing the **same** site. The reference to "while having a conversation" means using a chat room. Fernandes lacks any discussion about any of elements (a) through (g) of Applicant's independent claim 1. Fernandes does not teach providing a network site offering items for sale, monitoring user browsing patterns, identifying common browsing patterns, informing users of common browsing patterns, providing each of first and second users with capability to inform the network site of interest in co-browsing with each other, or providing capability for communication between the interested first and second users while they continue to shop at the network site. Fernandes teaches away from Applicant's invention because it describes chat rooms for online communities and the move toward adding audio and video exchanges and toward developing an ability to share and collaborate on documents in the context of a meeting environment.

2. Hodges

Hodges merely describes an environment in which the user reviewing a real estate database is provided with a button in the interface for each house within the database that allows the user to call a realtor via telephone. The user can select parameters for the telephone call among: voice only, voice and video, and voice with video and shared graphics and data. The call begins voice only, with the option of switching to a shared data mode, in which both the realtor and the user can view the same data on screen, even with financial figures entered by the realtor. Hodges lacks any discussion about communication between users shopping at a network site, nor does it teach or suggest providing for communication between first and second users identified by their common browsing pattern and informed of each other's common browsing pattern. Hodges does not teach monitoring the browsing patterns of first and second users, identifying common browsing patterns, informing users of common browsing patterns, or providing each of first and second users with capability to inform the network site of interest in co-browsing with each other.

3. Bull

Bull merely describes an information aggregation and synthesization system and process. Bull provides aggregation and packaging of structured or unstructured information from disparate sources such as those available on a network such as the Internet. A network compatible/addressable interface device is operated by a user. The network interface device communicates with local datastores or network accessible datastores via an addressing scheme such as Uniform Resource Locator addresses (URLs) utilized by the Internet. Data passing between the network interface device and the datastores is accessed, polled, and retrieved through an intermediary gateway system. Such aggregated information is then synthesized, customized, personalized and localized to meet the information resource requests specified by the user via the network interface device. The teachings of Bull are designed to use analysis of user browsing patterns to update profiles for the purpose of tailoring advertisements to individual user profiles (see, e.g., column 8, lines 23-30).

Contrary to the allegation at page 6 of the Office Action, Bull does not teach identifying a common browsing pattern of first and second users and informing said users of the common browsing pattern. In addition, Bull lacks any discussion about providing each of first and second

users with capability to inform the network site of interest in co-browsing with each other, or providing capability for communication between the interested first and second users while they continue to shop at the network site.

4. Sonnenreich

Sonnenreich merely describes a user-friendly method and system for integrating the use of a plurality of different communication techniques for over-the-Internet interfacing between a central server storing a plurality of different information topics and user identification information and a plurality of independent user computer stations which have selected common information topics and are widely geographically separated, for such purposes as information and dialog networking of schools and other groups with common topic interests, and enabling real-time intercommunication amongst such users and with the server, and including growing the information on the selected topics through Internet feedback to the server of user dialog and supplemental information relating thereto; the method creating a virtual common room atmosphere for all the users (such as the same virtual classroom) wherein, irrespective of the diverse geographical locations and actual distances of the varied user stations from one another and from the central server, real-time interactions are enabled amongst all simulating as if the users were all actually in the same room at the same time and participating together.

Sonnenreich lacks any discussion, however, about providing a network site offering items for sale, monitoring user browsing patterns, identifying common browsing patterns, informing users of common browsing patterns, providing each of first and second users with capability to inform the network site of interest in co-browsing with each other, or providing capability for communication between the interested first and second users while they continue to shop at the network site. Instead, Sonnenreich teaches away from Applicant's invention because it suggests that real-time intercommunication amongst users must be set up within a group of users who have first elected to become members of a group. This is in contrast with Applicant's method in which the browsing pattern of the users is monitored, and the capability for communication between interested first and second users is provided after identifying the common browsing pattern, informing the users of the common browsing pattern, and providing the users with capability to inform the network site of interest in co-browsing with the other user having a common interest.

C. THE PTO HAS NOT MET ITS BURDEN

Even when the numerous references cited by the Examiner are combined, the prior art fails to teach each element of Applicant's independent claims. Despite the vague indications (no identification of specific page and line numbers) at pages 6-7 of the Office Action of references that allegedly meet each of elements (a) through (g) of claim 1, review of the cited references shows that the elements cannot be found in these references. Accordingly, the Patent & Trademark Office (PTO) has not made out a *prima facie* case of obviousness because it has not shown that each element of the claims is taught or suggested in the prior art.

Moreover, a *prima facie* case of obviousness is lacking because the PTO has not shown where in the prior art a motivation or suggestion to combine the references can be found. At page 8 of the Office Action, second paragraph, it is alleged that it would have been obvious to combine the teachings of these cited references "because they all worked toward a similar field of interest, i.e., to apply simultaneously collaborative browsing techniques using the most available efficient step for ordering controls and managements in Internet." [sic] Yet not a single one of the cited references mentions "simultaneously collaborative browsing techniques". To the extent that any of the cited references refers to more than one user communicating while using a network site, these communications are initiated via an option generally presented to all users to contact other members of a group (e.g., realtors, fellow students enrolled in a distance-learning course, chat group). These communications are not initiated based on monitoring browsing patterns of users, identifying common browsing patterns between a first user and a second user, informing these users of their common browsing pattern, providing these users with capability to inform the network site of interest in co-browsing, and then providing a capability for communication between the interested first and second users.

When combined, the references actually teach away from Applicant's invention. For example, the combined references would teach offering a chat room available to all users browsing a network site. The user would select a pre-determined option and subsequently find out if other users having a common interest were also on-line. From the user's perspective, this is much different than having the communication initiated by the network site informing them of another user exhibiting a common browsing pattern.

Accordingly, the various elements of Applicant's claimed invention together provide operational advantages over the systems disclosed in Fernandes, Hodges, Bull, and Sonnenreich. In addition, Applicant's invention solves problems not recognized by Fernandes, Hodges, Bull, and Sonnenreich.

Thus, Applicant submits that independent claims 1, 11, and 21 are allowable over Fernandes, Hodges, Bull, and Sonnenreich. Further, dependent claims 2-10, 12-20, and 22-30 are submitted to be allowable over Fernandes, Hodges, Bull, and Sonnenreich in the same manner, because they are dependent on independent claims 1, 11, and 21, respectively, and contain all the limitations of the independent claims. In addition, dependent claims 2-10, 12-20, and 22-30 recite additional novel elements not shown by Fernandes, Hodges, Bull, and Sonnenreich.

For example, claim 2 relates to further providing the users with a window for interfacing with the network site, wherein the window comprises a first pane that displays information relating to items for sale and a second pane that displays content of the communication between the first and second user. At page 8 of the Office Action, fourth paragraph, it is alleged that Hodges, at pages 166-167, "clearly disclose a collaborative browsing case . . . wherein voice, video, and shared graphics and data were used simultaneously in different panes." Hodges teaches a shared-data mode in which the user and a realtor can view the same records simultaneously, while also talking on the phone. Hodges does not teach a second pane that displays content of the communication between the first and second user. In Hodges, the content of the communication is shared orally via the telephone and is not displayed in a window.

With regard to the remaining dependent claims, no references are cited as disclosing these features. Instead, it is alleged that "it would be obvious for one with ordinary skill in the art to provide such information within means of available communications". Applicant respectfully notes that this type of conclusory statement regarding the general knowledge in the art is not sufficient grounds for an obviousness rejection. *In re Lee*, 61 USPQ2d 1430 (Fed. Cir. 2002).

For the reasons presented above, it is respectfully requested that the rejections based on the prior art be withdrawn.

IV. CONCLUSION

In view of the above, it is submitted that this application is now in good order for allowance and such allowance is respectfully solicited. Should the Examiner believe minor matters still remain that can be resolved in a telephone interview, the Examiner is urged to call Applicant's undersigned attorney.

Respectfully submitted,

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